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10/665,029	09/16/2003	William Waycott	34703/0020	4492

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EXAMINER

ROBINSON, KEITH O NEAL

ART UNIT PAPER NUMBER

1638

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/665,029

Applicant(s)

WAYCOTT, WILLIAM

Examiner

Keith O. Robinson, Ph.D.

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,38,39 and 41-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,38,39 and 41-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The cancellation of claims 4 and 10-37, the amendments of claims 1-3, 5-7, 38-39 and 41-45 and the addition of new claims 46-56, filed February 27, 2006, have been received and entered in full.
2. Claims 1-3, 5-7, 38, 39 and 41-56 are pending.

### ***Response to Arguments***

3. Applicant's arguments, see 'Remarks', page 8-9, filed February 27, 2006, with respect to the objection of claims 38-43 and the specification regarding deposit information, have been fully considered and are persuasive. The objections have been withdrawn.
4. Applicant's arguments, see 'Remarks', pages 9-10, filed February 27, 2006, with respect to the 35 U.S.C. § 101 rejection, have been fully considered and are persuasive. The rejection has been withdrawn.
5. Applicant's arguments, see 'Remarks', pages 16-17, filed February 27, 2006, with respect to the 35 U.S.C. § 112, second paragraph rejection, have been fully considered and are persuasive. The rejection has been withdrawn.
6. Applicant's arguments, see 'Remarks', pages 17-19, filed February 27, 2006, with respect to the 35 U.S.C. § 102, have been fully considered and are persuasive. The rejection has been withdrawn.

***Double Patenting***

7. Claims 1-4 and 6-9 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 8-16 of U.S. Patent No. 6,689,941. The rejection is repeated for the reasons of record as set forth in the Office Action mailed August 25, 2005, page 3. Applicant has not filed a terminal disclaimer in compliance with 37 CFR 1.321 (c) and thus, has not overcome the rejection.

***Claim Rejections - 35 USC § 112, first paragraph – Written Description***

8. Claims 1-3, 5-7 and 41-45 remain rejected and new claims 46-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is repeated for the reasons of record as set forth in the Office Action mailed August 25, 2005, as applied to claims 1-7 and 41-45. Applicant's arguments filed February 27, 2006 have been fully considered but they are not persuasive.

Applicant argues the specification and claims as originally filed adequately support the claimed invention (see page 11, 1<sup>st</sup> paragraph of 'Remarks' filed February 27, 2006).

This is not persuasive. Even though "the specification discloses numerous physiological characteristics of the iceberg lettuce cultivars", as stated by Applicant on

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page 11, 1<sup>st</sup> paragraph of 'Remarks' filed February 27, 2006, this does not provide an adequate written description of the claimed invention. The MPEP states "[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., > Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003);< Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563, 19 USPQ2d at 1116. However, a showing of possession alone does not cure the lack of a written description. Enzo Biochem, Inc. v. Gen-Probe, Inc., \*\*>323 F.3d 956, 969-70,< 63 USPQ2d 1609, 1617 (Fed. Cir. 2002)".

The claims are broadly drawn to any and all lettuce plants having the claimed characteristics and there is no evidence in the specification that would allow one skilled in the art to conclude that Applicant has possession of all lettuce plants having the claimed characteristics.

See *Vas-Cath Inc. v. Mahurkar* 1991 (CA FC) 19 USPQ2d 1111, 1115, which teaches that the purpose of the written description is for the purpose of warning an innocent purchaser, or other person using a machine, of his infringement of the patent; and at the same time, of taking from the inventor the means of practicing upon the credulity or the fears of other persons, by pretending that his invention is more than what it really is, or different from its ostensible objects, that the patentee is required to distinguish his invention in his specification.

The specification does not allow one skilled in the art to distinguish the claimed invention from any other lettuce plants with the same characteristics.

Applicant argues that the hybrid plants are adequately described because one of the parents is described (see pages 12-13 of 'Remarks' filed February 27, 2006).

This is not persuasive. It is known in the art that a hybrid is produced by crossing at least two different parents. If one of the two parents is not adequately described, as is the case for the claimed hybrids, then the claimed hybrid cannot be described. Knowing half of the genetic composition of a plant is not an adequate description because a hybrid will possess 50% of the genes of the other parent wherein these genes will play a significant role in the morphological and physiological characteristics of the claimed hybrid.

***Claim Rejections - 35 USC § 112, first paragraph - Enablement***

9. Claims 1-3, 5-9 and 38-45 remain rejected and new claims 46-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection is repeated for the reasons of record as set forth in the Office Action mailed August 25, 2005 (pages 8-14), as applied to claims 1-9 and 38-45. Applicant's arguments filed February 27, 2006 have been fully considered but they are not persuasive.

Applicant argues a 'Deposit Declaration' will be provided indicating that lettuce cultivar 'PSR 6425' has been deposited upon an indication that the subject matter is allowable (see page 13, 1<sup>st</sup> paragraph of 'Remarks' filed February 27, 2006).

This is not persuasive. As stated in the previous Office Action mailed August 25, 2005, pages 9-10, the deposit information is incomplete as there is no reference regarding the criteria set forth in 37 C.F.R. 1.801-1.809 or any statement by an attorney of record over his or her signature and resignation number showing that the conditions of (a)-(e) on page 9 of the previous Office Action mailed August 25, 2005.

Applicant argues that the specification discloses sufficient guidance to produce the claimed lettuce plants because the specification describes methods for breeding iceberg lettuce cultivars (see page 14, 2<sup>nd</sup> paragraph of 'Remarks' filed February 27, 2006).

This is not persuasive. As discussed in the previous Office Action mailed August 25, 2006 on pages 10-11, the claims are broadly drawn to the broad genus of iceberg lettuce plants with the claimed characteristics. The specification may describe lettuce breeding methods, but this does not enable one skilled in the art to make and use the claimed invention without undue trial and error experimentation. One of skill in the art would not know the starting material to produce the claimed invention with the exact characteristics as claimed; therefore, one skilled in the art would have to screen literally thousands of lettuce plants to find which, if any, would have the exact characteristics of the claimed invention. Also, one skilled in the art would not be able to distinguish the claimed invention from other lettuce cultivars that have the same characteristics.

Applicant argues that the skilled artisan would be able to obtain F1 hybrids such the claimed cultivars without undue experimentation (see page 14, last paragraph to page 15, end of 1<sup>st</sup> paragraph).

This is not persuasive. The Examiner agrees that one skilled in the art could in fact make hybrid lettuce plants, but one skilled in the art would not be able to use the claimed hybrids without guidance as to the second parent used to produce the claimed hybrids.

Applicant argues that there is no nexus provided between the cited references relating corn breeding with iceberg lettuce breeding programs (see page 15, 2<sup>nd</sup> paragraph of 'Remarks' filed February 27, 2006).

This is not persuasive. The references were cited to show the unpredictability in the field of plant breeding. The fact that some of the references referred to corn is irrelevant because it is known in the art that breeding for specific characteristics is unpredictable as it depends on many factors beyond the breeder's control. In addition, Applicant has failed to provide any evidence to overcome the rejection.

Applicant argues that the Examiner's use of language in the instant specification to support unpredictability in lettuce breeding is misplaced (see page 15, last paragraph to page 16, end of 1<sup>st</sup> paragraph).

This is not persuasive. Applicant's invention does not overcome the inherent unpredictability in plant breeding. The statement from the specification used by the Examiner is not misplaced as it supports the Examiner's argument for unpredictability in plant breeding for specific traits.



Applicant argues that in using the Ryder et al reference the Examiner does not correlate the alleged epistatic interactions discussed in Ryder et al to any epistatic interactions between the characteristics of the claimed iceberg lettuce cultivars.

This is not persuasive. The reference was used to show that epistatic interactions in genes can occur in lettuce cultivars. Applicant has not provided any information that shows that epistatic interactions do not occur in lettuce breeding.

***Claim Rejections - 35 USC § 102/103***

10. Claims 41-45 remain rejected and new claim 50 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bassett (J. Amer. Soc. Hort. Sci. 100(2): 104-105, 1975). The rejection is repeated for the reasons of record as set forth in the Office Action mailed August 25, 2005 (pages 16-17), as applied to claims 41-45. Applicant's arguments filed February 27, 2006 have been fully considered but they are not persuasive.

Applicant argues that Bassett does not teach F1 hybrid lettuce plants having one or more parents grown from the seed of *L. sativa* line PSR 642, PSR 6595, or PSR 6032 (see page 19, paragraphs 2-4 of 'Remarks' filed February 27, 2006).

This is not persuasive. As stated in the previous Office Action, page 17, mailed August 25, 2006 the use of the claimed *L. sativa* lines with unspecified breeding partners would not confer a unique characteristic to the claimed hybrids which would distinguish them from the prior art plants. Thus, the claimed hybrids read on any lettuce plant; therefore, the cited reference is not improper.

**Conclusion**

11. No claims are allowed.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith O. Robinson, Ph.D.

May 5, 2006

DAVID H. KRUSE, PH.D.  
PRIMARY EXAMINER

